

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS E. ORLOWSKI,  
DONALD S. SYPULA,  
JOSEPH MAMMINO,  
JOHN W. SPIEWAK  
and RAYMOND E. BAILEY

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Appeal No. 94-3960  
Application 07/997,489<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, WEIFFENBACH and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed December 28, 1992.

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Thomas E. Orlowski et al. (Appellants) appeal from the examiner's final rejection of claims 1 through 24, which are all the claims remaining in the application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A process for preparing a donor roll having an electrode pattern comprising:

(a) providing a cylindrically shaped insulating member;

(b) coating the insulating member with a photo or thermally sensitive composition comprised of a polymeric material and a conductive metal nucleating agent;

(c) patterning the composition, resulting in a first composition portion corresponding to the electrode pattern and a second composition portion; and

(d) depositing conductive metal on the first composition portion, resulting in the electrode pattern which is capable of being electrically biased to enable detachment of toner particles from the donor roll.

According to the specification, the term "a donor roll" is defined as a device for "transporting charged toner to the development zone." See specification, page 1. The donor roll must not only be capable of attracting toner from a magnetic roll, but also be capable of being electrically biased to enable detachment of toner to cause formation of a toner

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powder cloud in the development zone. See specification, page 2. In other words, this donor roll must be useful for electrophotographic printing or copying apparatuses. See specification, page 1.

Claims 1 through 24 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of the following references<sup>2</sup>:

Babu et al (Babu) 1988	4,718,972	Jan. 12,
Akahoshi et al (Akahoshi) 1989	4,876,177	Oct. 24,
Greene et al (Greene) 1992	5,171,608	Dec. 15,

According to the examiner, the references relied upon disclose "the same sequence of steps" as claimed except for using a cylindrical substrate in those steps. See Answer, page 6. In so stating, the examiner failed to take into account the preambular limitation "a donor roll". See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir.

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<sup>2</sup> The examiner relies on the following new reference to further explain his position:

Yuh et al (Yuh)	5,063,125	Nov. 5, 1991
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1989)(when the introductory words of a claim, the preamble, do give life and meaning to the invention claimed, those words constitute additional structural limitations); In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974)("every limitation in the claims must be given effect..."). Failure to consider the meaning of "a donor roll" constitutes a reversible error.

To the extent the examiner might have considered the preambular limitation "a donor roll" (see Answer, page 8), the examiner's consideration is deemed inadequate. The examiner simply failed to proffer any explanation or evidence as to why one of ordinary skill in the art would have been led to apply a method for making a printed circuit board, a photoreceptor or a photolithography for the purposes of making "a donor roll". On this record, we are constrained to reverse the rejection of claims 1 through 24.

The decision of the examiner is reversed.

REVERSED

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	JOHN D. SMITH	)	
	Administrative Patent Judge	)	
		)	
		)	
	CAMERON WEIFFENBACH	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS
		)	AND
		)	
INTERFERENCES		)	
	CHUNG K. PAK	)	
	Administrative Patent Judge	)	
		)	

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